

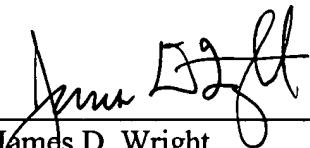
REMARKS

Claims 1 through 28 are currently pending in the above-captioned application. On page 3 of the Office Action, the Examiner objected to Claims 21 and 22 as being dependent upon a rejected base claim. In addition, on page 2 of the Office Action, Claims 1, 18 and 23 were rejected under 35 U.S.C. § 102(b) as being anticipated by Davis, U.S. Patent No. 3,168,312 ("Davis"), and on page 3, Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Davis. The Examiner has indicated in paragraph 3 on page 3 of the Office Action that Claims 7-10 are allowed. Claims 2, 5, 25, and 26 have been canceled. Claims 3, 4, 6, 11-17, 24, 27 and 28 have been withdrawn in response to a requirement for restriction. Applicant has submitted an appeal brief concurrent herewith appealing the rejections of Claims 1, 18, 19, 20 and 23.

With regard to the objections to Claims 21 and 22, Applicant submits that the objections have been addressed by amending Claims 21 and 22 to place them in independent form. No new matter has been added. Accordingly, Applicant respectfully requests reconsideration and withdrawal of each of the objections.

In view of the foregoing, it is respectfully urged that Claims 21 and 22 are in condition for allowance and reconsideration is requested. An early notice to this effect is earnestly solicited. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned at the number shown below.

Respectfully submitted,

  
\_\_\_\_\_  
James D. Wright  
Reg. No. 43,291  
Kennedy Covington Lobdell & Hickman, LLP  
Hearst Tower, 47<sup>th</sup> Floor  
214 North Tryon Street  
Charlotte, North Carolina 28202  
Telephone (704) 331-7400  
-- Attorney for Applicants

Attorney Docket No.: 019441.023

## **II. Related Appeals and Interferences**

Appellant is not aware of any related appeals or interference proceedings.

## **III. Status of Claims**

Claims 1, 3, 4, 6-24, 27 and 28 are presently pending in the present application. Claims 7-10 have been previously allowed. Claims 2, 5, 25 and 26 have been cancelled. Claims 3, 4, 6, 11-17, 24, 27 and 28 have been withdrawn in response to a requirement for restriction. Claims 1, 18 and 23 stand finally rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 3,168,312 to Davis ("Davis"). Claims 19 and 20 stand finally rejected under 35 U.S.C. § 103(a) as being allegedly being unpatentable over Davis. Claims 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Appellant has submitted an amendment concurrent herewith to place claims 21 and 22 in allowable form.

Appellant is appealing the final rejection of Claims 1, 18-20 and 23, each of which is reproduced in its entirety in Appendix A attached hereto.

There are no other claims pending, cancelled or withdrawn that are associated with this application.

## **IV. Status of Amendments**

All amendments have been entered. As referenced previously, an amendment filed concurrently with this Appeal Brief rewrites claims 21 and 22 as independent claims to overcome the objections raised by the Examiner concerning these claims. Appellant believes

that the concurrently filed amendment follows suggestions by the Examiner and places claims 21 and 22 in condition for allowance.

#### **V. Summary of the Invention**

The golf practice and exercise device of the present invention provides a golfer with a strike-able object to promote muscle development without forcing the golfer to concentrate on hitting a small object ( i.e. a golf ball), and also to improve golf swing technique without having to continually retrieve the struck object. (Specification p. 2, lines 2-18). The golf practice and exercise device comprises a frame having a flat base portion and an upright portion extending upwardly from the base portion. (Id. at p. 5, lines 7-9.) A mounting arm projects outwardly from the frame portion over a portion of the base portion. (Id. at lines 9-11.) At the outward end of the mounting arm, an object is suspended so that the object can be struck by a golf clubhead swung by a golfer. (Id. at lines 11-14.) At least a portion of the object is adjacent the floor or ground. (Id. at lines 12-14 and claim 1.) The size of the golf clubhead impact surface of the object is at least that of a conventional softball. (Id. at p. 7 lines 15-17.) The size of the golf clubhead impact surface allows the golfer to swing a golf club without having to concentrate on striking a small target such as a golf ball. (Id. at p. 6 lines 18-20.) The mass of the object is at least that of a conventional softball. (Id. at p. 7 lines 15-19.) The mass of the object provides for muscle development for increased performance when hitting a golf ball while allowing the clubhead to move under the object for completion of the follow-through of the swing. (Id. at pp. 6-7, lines 20-9.)

The object is suspended from the mounting arm by a flexible cord. (Id. at p. 5, line 12 and claim 18.) The flexible cord is attached to a ring that is freely rotatably mounted at the

outward end of the mounting arm so that, when struck, the object, cord and ring rotate about a generally horizontal axis. (Id. at lines 20-22, and claim 21.) The mounting arm is adjustable to a height of between about 1.5 feet and about 5 feet above the base, preferably about 3 feet. (Id. at p. 7 lines 12-14 and claims 19 and 20.) The object may be selectively attached to the base portion of the frame to restrain the object against movement for alternative use of the object as a stop of the golf club in an impact position, thus allowing the golfer to practice a golf swing technique. (Id. at page 8, lines 1-6 and claim 22 and 23.)

## **VI. Issues**

There are two issues on appeal: first whether Claims 1, 18 and 23 are unpatentable under 35 U.S.C. 102(b) as anticipated by Davis; and, second whether Claims 19 and 20 are unpatentable as obvious over Davis under 35 U.S.C. 103(a).

## **VII. Grouping of Claims**

With respect to the issues on appeal, Claims 1, 18-20 and 23 stand or fall together.

## **VIII. Argument**

THE REJECTION OF CLAIMS 1, 18 AND 23 AS ANTICIPATED BY DAVIS PURSUANT TO 35 U.S.C. § 102(b) SHOULD BE REVERSED BECAUSE DAVIS DOES NOT DISCLOSE EACH AND EVERY ELEMENT RECITED IN THE CLAIMS.

The rejection of Claims 1, 18 and 23 pursuant to 35 U.S.C. § 102(b) asserts that "Davis discloses a frame comprising a base, a vertical stand, a horizontal arm attached to the stand, a flexible cord attached to the horizontal arm, and a ball attached to the flexible cord adjacent the

ground." (Final Action, p. 2.) In addition, the rejection asserts that "Davis further discloses the device utilized for balls of differing weights and densities and may be struck with various types of striking implements," and that Davis describes "softballs and baseballs" as examples of larger types of balls "that can be accommodated by the device." (Id.)

Applicant agrees that the apparatus disclosed by Davis may be used with a variety of ball types, including tennis balls, baseballs and softballs. (Col. 1, lines 63-71.) Significantly, however, Davis fails to disclose the use of a striking implement, designed for use in one sport, to strike balls from a different sport, wherein the ball is specifically selected to be of a type having very different characteristics from those of the ball with which the striking implement is intended to be used. In other words, although Davis discloses the use of golf clubs (to hit golf balls) and tennis rackets (to hit tennis balls), Davis does not disclose the use of golf clubs to hit tennis balls. In the Final Action dated May 23, 2003, the Examiner admits as much, agreeing with Applicant's argument ("[Davis] does not teach or disclose utilizing a ball of a weight and size for one sport being used to practice another sport") (Final Action, p. 4).

Regrettably, however, the Examiner has asserted that this distinction only relates to a method of use of an apparatus, and that "[t]he method of using an apparatus is not a patentable distinction." (Id.) Moreover, the Examiner asserts that "[A]pplicant is not entitled to a patent for an apparatus with identical structural features as the prior art with a different method of use." (Id.) The Examiner concludes that "the apparatus as claimed by [A]pplicant is identical to the apparatus disclosed by Davis," and that "[w]hile the methods of using the apparatus may be different the structural features are the same." (Id.)

As set forth hereinbelow, Applicant respectfully submits that the Examiner's conclusions regarding the asserted lack of distinction between the claimed apparatus and the apparatus

disclosed by Davis to be erroneous. In fact, Applicant respectfully points out that Claims 1 and 23 contain structural limitations that distinguish the claimed apparatuses from the device or devices disclosed by the Davis patent and that these distinctions are structural, not method, distinctions.

For example, Claim 1 recites “an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club.” Similarly, Claim 23 recites “an object...extending between said mounting arm and said base in position for striking by a golf clubhead during a normal golf swing and stopping the golf clubhead in an impact position.” These are structural limitations defining the position of the object. Although in describing this position, reference is made to a golf clubhead, the language nonetheless provides a structural limitation placed on the position of the object in relation to the ground.

Davis likewise describes the placement of an “object” in terms of the striking implement with which it is to be used. Importantly, however, Davis teaches that the specific placement of the object is dependent upon the type of striking implement to be used. (Col. 4, lines 34-49.) In other words, if the object is a baseball, then it should be “positioned in a theoretical strike zone between the housing and the ground” (col. 4, lines 39-41), while if the object is a golf ball, then it should “rest upon the ground” so that it is “in a position to be struck by a driving wood or pitching iron of the golfer” (col. 4, lines 41-45). Davis notably does not teach any apparatus that includes any object, other than a golf ball, that is “suspended...with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club.”

With further regard to claim 1, the "object" that is recited as being part of the "golf practice and exercise device" claimed in the present invention must be "of a mass at least that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of a golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow-through of the golf swing." This is likewise a structural limitation on the claimed apparatus, defining the mass of the "object." While it is defined in terms of the amount of resistance it would impose on a golf club, it is nonetheless a structural limitation. Similarly, the swingable mounting of the object and the mass are limited to a structure that is such as to "impose muscular strain on the golfer," and the structure is further limited by the requirement that if the object were to be swung in response to being hit by a golf clubhead, the object must allow "the golf clubhead to ultimately pass under the object" as the object swings on its mounting. Although the terms used to describe such structural limitations pertain to the use of the claimed apparatus, these limitations nevertheless are placed on the "object" that is required as part of the apparatus itself, and thus may not be ignored.

As stated previously, Davis fails to disclose the structure claimed by Applicant in the present application. In effect, Davis discloses a variety of automatic ball retrieving devices, including one device for retrieving (or more accurately, retaining) a golf ball, another device for retrieving a tennis ball, and still another device for retrieving a softball. In a sense, each of these devices could theoretically be viewed as a practice or exercise device targeted toward a particular sport; i.e., the golf ball retrieving device could be viewed as a golf practice or exercise device, and the softball retrieving device could be viewed as a softball practice or exercise device. However, Davis does not disclose a "golf practice and exercise device" that includes, as a part

thereof, an object having "a mass at least that of a softball" or that meets the other requirements pertaining to mass that are claimed by the present application. Instead, Davis at most discloses only a softball practice or exercise device that includes the claimed object.

Independent Claim 23 also requires an object "secured to and extending between said mounting arm and said base." This limitation, which is purely structural and makes no reference whatsoever to its use, has been completely overlooked by the Examiner. Davis does not disclose any ball (or any other object, for that matter), that is secured to the mounting arm and to the base, and in fact, such an arrangement would defeat the entire purpose of the Davis device, which is really directed toward the retrieval of balls, and not to a exercise device.

More egregiously, the Examiner has failed to offer any evidence whatsoever as to the structural element or elements in the cited prior art on which the Examiner has based the rejection of this claim. In fact, the only statement whatsoever offered by the Examiner with regard to independent Claim 23 was the Examiner's conclusory statement that it was rejected as "clearly anticipated by Davis." Reproduced below is the entire text of the Examiner's rejection of Claim 23:

Claims 1, 18 and 23 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Davis (3,168,312). Davis discloses a frame comprising a base, a vertical stand, a horizontal arm attached to the stand, a flexible cord attached to the horizontal arm, and a ball attached to the flexible cord adjacent the ground (see fig 1). Davis further discloses the device utilized for balls of differing weights and densities and may be struck with various types of striking implements (col 2, lines 1-5). Davis gives examples of softballs and baseballs as the type of larger ball that can be accommodated by the device (col 1, lines 65-70).

(Final Action, May 23, 2003, p. 2.)

The Examiner subsequently responds to Applicant's prior arguments, but was no more forthcoming about the reasons for the Examiner's rejection of Claim 23:

Applicant comments with regards to the examining procedures during the prosecution of the present application have been noted. The Examiner apologizes for any inconvenience incurred by the applicant. However, prior art deemed applicable by the Examiner cannot be ignored during any part of the prosecution. In regards to the Davis reference, the rejection is maintained. The structural limitations claimed by applicant are clearly disclosed by Davis as shown above. Applicant argues the method of using the device is different from the method disclosed by Davis. For example, applicant states "while the Davis patent discloses that the retrieving device can be used with various types of ball, it discloses that the ball is selected to practice the sport for which the ball is intended, i.e. a baseball for practicing baseball, a gold ball for practicing golf, a tennis ball for practicing tennis..... It does not teach or disclose utilizing a ball of a weight and size for one sport being used to practice another sport." The Examiner agrees with applicant's statement in regards to the prior art. However, applicant is not entitled to a patent for an apparatus with identical structural features as the prior art with a different method of use. The method of using an apparatus is not a patentable distinction. As shown above, the apparatus claimed by applicant is identical to the apparatus disclosed by Davis. While the methods of using the apparatus may be different the structural features are the same.

(Id., p. 3.)

Applicant respectfully submits that the Examiner failed to provide any evidence supporting the rejection of Claim 23 because there was no reason to reject Claim 23. Applicant suspects that Claim 23 was, in fact, overlooked by the Examiner in issuing the first Official Action following the first Appeal Brief filed in the present case. More specifically, and as evident from the prosecution history of the present application, Claims 1 and 18-23 were all appealed from the Examiner's previous Final Action, dated May 20, 2002. After review of Applicant's first Appeal Brief, dated September 24, 2002, the Examiner underwent a change of heart with regard to prior art previously cited against Applicant, particularly U.S. Patent No. 1,847,570 to McLaughlin ("McLaughlin") and U.S. Design Patent No. D366,679 to Clements ("Clements"). Instead, the Examiner found an entirely new grounds for rejection in the Davis patent. However, possibly because Claim 23 had been previously grouped with Claims 1 and 18-22 for purposes of the appeal, the Examiner erroneously applied the Davis patent in rejecting

Claim 23 in both the first Official Action (dated December 18, 2002) and in the subsequent Final Action (dated May 23, 2003).

Therefore, the rejection of Claims 1, 18 and 23 as being anticipated by the Davis patent should be reversed.

THE REJECTION OF CLAIMS 19 AND 20 AS BEING OBVIOUS OVER DAVIS PURSUANT TO 35 U.S.C. § 103(a) SHOULD BE REVERSED BECAUSE THERE IS NO SUGGESTION IN DAVIS THAT RENDERS OBVIOUS EACH AND EVERY ELEMENT OF THE CLAIMS.

As stated above, Claims 19 and 20 depend from Claim 1. Therefore, Claims 19 and 20 are patentable for the same reasons as stated above for Claim 1, and the rejection should be reversed.

However, the rejection of Claims 19 and 20 should also be reversed for additional reasons. In rejecting Claims 19 and 20 pursuant to 35 U.S.C. § 103(a), the Examiner first asserts that “Davis discloses the invention as shown above” but admits that Davis “fails to include the height of the frame.” The Examiner then asserts that “Davis discloses the device may be used for a variety of sports,” that “Davis gives examples of using softballs and baseballs,” and that “[i]t is obvious the height of the frame would fall between 1 ½ and 5 feet to accommodate the heights associated with sports such as softball and baseball.”

Applicant respectfully submits that the Examiner erred in concluding that it would be obvious to modify the device disclosed by Davis to meet the claimed frame height dimensions. The claimed dimensions are much more suitable for use with a golf practice device than with a softball practice device. Hitting a softball suspended from an arm that is only 3 feet above the ground or floor would be exceedingly difficult with a bat when swung in a conventional manner,

and would be nearly impossible if the arm were only 1 ½ feet above the floor. Moreover, even the claimed maximum height of 5 feet would be too low a point from which to suspend a softball for many taller batters.

As discussed in detail hereinabove, the claimed apparatus is clearly designed for particular use by a golfer with a golf club, and the claimed object to be struck with the golf club is at least of "softball" mass. On the other hand, Davis effectively discloses a golf ball retrieval device and softball retrieval device, but not a device for retrieving (or retaining) a softball struck by a golf club. This distinction is important, because Davis clearly did not contemplate the use of a softball with a golf club, or the use of any other type of ball (except a golf ball) with a golf club. Thus, the dimensions of the Davis device are clearly selected based on the type of ball and striking implement to be used therewith.

The Examiner states that it would be "obvious" to apply the claimed dimensions to the "arm" of the softball retrieving device of Davis. Because the softball retrieving device includes an "object" the size of a softball, the Examiner concludes that the use of such dimensions would therefore produce the apparatus described in Claims 21 and 22. However, as evident from the foregoing, it would be unlikely that anyone trying to create a "softball retrieving device" would choose a height of 1 ½ or 3 or even 5 feet from which to suspend the softball.

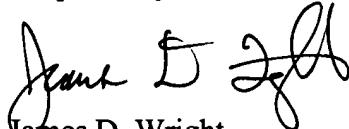
In view of the fact that the claimed dimensions are much more applicable to a golf practice environment than a softball practice environment, then, Applicant respectfully submits that a user might modify the golf ball retrieving device of Davis, and only that device, to place the "arm" at the claimed height. However, Davis does not disclose the use of an object having "a mass at least that of a softball" with such a device.

There is no disclosure in Davis of a "golf practice and exercise device" that includes an object having "a mass at least that of a softball" suspended from an arm that is 1 ½ feet to 5 feet, or particularly 3 feet, above the ground or floor. There would likewise be no motivation for one of ordinary skill in the art to either modify the golf ball retrieving device of Davis to include a softball-sized object, or modify the softball retrieval device of Davis to place the "arm" at the claimed height. Therefore, there is no basis for an obviousness rejection of Claims 19 and 20 and such rejection should be reversed.

#### **IX. Conclusion**

Therefore, for all of the aforementioned reasons, it is respectfully submitted that the final rejections should be reversed and that the pending claims be found allowable. Enclosed herewith is the fee of \$165.00 due for the filing of this Appeal Brief. The Commissioner is also authorized to charge any other fee which is due or to credit any fee overpayment which has been made to Deposit Account No. 18-1215.

Respectfully submitted,



James D. Wright  
U.S. Reg. No. 43,291  
Kennedy Covington Lobdell & Hickman, L.L.P.  
Hearst Tower, 47<sup>th</sup> Floor  
214 North Tryon Street  
Charlotte, NC 28202  
(704) 331-7563

## APPENDIX A

1. A golf practice and exercise device for use with a golf club, comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object swingably suspended from said mounting arm with at least a portion of said object adjacent the floor or ground in position to be struck by a golf clubhead during a normal swing of a golf club, said object having a golf clubhead impact surface of a size at least that of the corresponding surface of a softball to provide a large target so that the golfer can swing a golf club freely without concentration on striking the small target of a golf ball, said object being of a mass at least that of a softball to provide substantial resistance to the impact of a golf club to impose muscular strain on the golfer for muscle development but being limited in mass to allow the head of a golf club to swing the object sufficiently for the golf clubhead to ultimately pass under the object and allow the golfer to complete the follow-through of the golf swing.

18. A golf practice and exercise device according to claim 1 in which said object is suspended from said mounting arm by a flexible cord.

19. A golf practice and exercise device according to claim 18 in which said arm is approximately 1½ to 5 feet above the ground or floor.

20. A golf practice and exercise device according to claim 18 in which said arm is approximately 3 feet above the ground or floor.

23. A golf practice and exercise device comprising a frame member having a base portion for supporting the device on a floor or ground, said frame member extending upwardly from the base member and having an outwardly extending mounting arm, and an object secured

to and extending between said mounting arm and said base in position for striking by a golf clubhead during a normal golf swing and stopping the golf clubhead in an impact position.